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ATTORNEYS AT LAW

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DATE: April 28, 2006

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TO: MAILSTOP PETITIONS  
COMPANY: U.S. Patent and Trademark Office

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FROM: Gregory B. Coy, Esq., Reg. No. 40,967

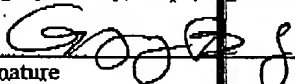
DIRECT DIAL: (317) 636-4341  
FAX NUMBER: (317) 636-1507

RE: U.S. Patent Application No. 10/781,058 / Petition for Withdrawal of Finality

COMMENTS: I hereby certify that this Petition Under 37 CFR §1.181 for Withdrawal of Finality of Premature Final Rejection is being facsimile transmitted to the United States Patent and Trademark Office at 571-273-8300 on:

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**TRANSMITTAL  
FORM**

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

Application Number 10/781,058

Filing Date February 18, 2004

First Named Inventor John Pafford, et al.

Art Unit 3738

Examiner Name David J. Isabella

Attorney Docket Number MSDI-455

**ENCLOSURES (Check all that apply)**

- ☐ Fee Transmittal Form
- ☐ Fee Attached
- ☐ Amendment/Reply
- ☐ After Final
- ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement

- ☐ Certified Copy of Priority Document(s)
- ☐ Reply to Missing Parts/Incomplete Application
- ☐ Reply to Missing Parts under 37 CFR 1.52 or 1.53


- ☐ Drawing(s)
- ☐ Licensing-related Papers
- ☒ Petition
- ☐ Petition to Convert to a Provisional Application
- ☐ Power of Attorney, Revocation
- ☐ Change of Correspondence Address
- ☐ Terminal Disclaimer
- ☐ Request for Refund
- ☐ CD, Number of CD(s) \_\_\_\_\_
- ☐ Landscape Table on CD

- ☐ After Allowance Communication to TC
- ☐ Appeal Communication to Board of Appeals and Interferences
- ☐ Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
- ☐ Proprietary Information
- ☐ Status Letter
- ☒ Other Enclosure(s) (please identify below):  
Facsimile cover sheet

Remarks

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm Name Kreg DeVault, LLP

Signature 

Printed name Gregory B. Coy

Date April 28, 2006

Reg. No. 40,987

**CERTIFICATE OF TRANSMISSION/MAILING**

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Typed or printed name Gregory B. Coy

Date April 28, 2006

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

John Pafford, et al.

Serial No. 10/781,058

Filed: February 18, 2004

BONE GRAFTS

)  
) Before the Examiner

) David J. Isabella

)  
) Group Art Unit 3738

)  
) April 28, 2006

**PETITION UNDER 37 CFR §1.181 FOR WITHDRAWAL OF  
FINALITY OF PREMATURE FINAL REJECTION**

**MAILSTOP PETITIONS**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

For the reasons set forth herein, Applicant submits that the Office Action dated February 28, 2006, is a premature final rejection, and respectfully requests withdrawal of finality of the rejection. No fees are believed to be required for this request, however, if any fees are deemed necessary, please charge said fees to Deposit Account No. 12-2424, but not to include the payment of any issue fee.

PETITION UNDER 37 CFR §1.181  
Serial No. 10/781,058  
Attorney Docket No. MSDI-455  
Page 1 of 4

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office at 571-273-8300 on September 6, 2005.

\_\_\_\_\_  
Gregory B. Coy

\_\_\_\_\_  
Name of Registered Representative

\_\_\_\_\_  
Signature

\_\_\_\_\_  
Date of Signature

### REMARKS

Applicant will address the substantive assertions made in the outstanding Office Action dated February 28, 2006, under separate cover. The purpose of this paper is to request withdrawal of the Examiner's holding of finality of the rejection. Reconsideration of the holding of finality in view of the following remarks is respectfully requested.

#### Statement of Facts

On April 5, 2005, a first substantive Office Action was issued in the present case. The only rejection of claims asserted in the Office Action was based on a combination of three references (Grivas, et al., Heggeness, et al., and McKay) under 35 U.S.C. 103(a).

On September 6, 2005, Applicant submitted a response to the April 5, 2005, Office Action. In the September 6 response, no claims were amended. Applicant simply pointed out that the McKay reference, upon which each rejection relied, does not qualify as prior art to the present application because the effective filing date of the present application precedes the filing date of the McKay reference.

While not required by any claim rejection, for the purpose of preventing another erroneous rejection and thereby expediting the allowance of this case, Applicant also pointed out in the September 6, 2005, response that a prior case to which McKay claims priority as a CIP application also does not qualify as prior art to the present case because it is commonly owned with the present application.

On February 28, 2006, a second substantive Office Action was issued in the present case. In the February 28, 2006, Action, the Examiner asserted new grounds of

rejection by rejecting many claims based on a new combination of references (Grivas, et al., Heggeness, et al., and either O'Leary et al., or Prewett et al.) under 35 U.S.C. 103(a).

The new ground of rejection was not necessitated by any claim amendment or newly-submitted IDS, or any other action by the Applicant, but was rather necessitated solely by the erroneous rejection of claims in the prior Office Action using a reference that did not qualify as prior art.

Remarks

As stated in Section 706.07(a) of the Manual of Patent Examining Procedure ("MPEP"), "second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)." (emphasis added). This same section of the MPEP also states that, "If [a statement of common ownership] is filed in reply to [a] 35 U.S.C. 102(e)/103 rejection and the claims are not amended, the examiner may not make the next Office action final if a new rejection is made." Because (1) Applicant's September 6, 2005, response to the first substantive Office action did not amend any claim, (2) Applicant has submitted no new information in any information disclosure statement since the time of the first substantive Office Action, (3) Applicant's September 6, 2005, response simply pointed out how a cited reference does not qualify as prior art and how another patent related to the cited reference also does not qualify as prior art, and (4) the

Office Action dated February 28, 2006 asserts a new ground for rejecting claims, Applicant submits that the outstanding Action dated February 28, 2006, cannot properly be made final.

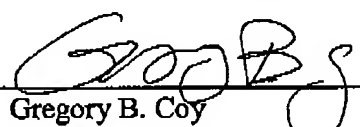
In addition to the above, MPEP §706.07 states that, "Before final rejection is in order a clear issue should be developed between the examiner and the applicant." Applicant submits that no clear issue has developed to date in the present case because Applicant has not had an opportunity to respond substantively to the rejection asserted in the outstanding Action. Because the rejection asserted in the first substantive Action was flawed, a substantive response to that rejection was not warranted.

**Closing**

In view of the above, Applicant respectfully submits that the holding of finality in the outstanding Office Action is premature, and respectfully requests withdrawal of finality of same. Applicant is prepared to respond substantively to the outstanding Action under separate cover.

Respectfully submitted,

By: \_\_\_\_\_

  
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PETITION UNDER 37 CFR §1.581  
Serial No. 10/781,058  
Attorney Docket No. MSDI-455  
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